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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,776	10/18/2000	Carolyn E. Mountford	1274/60326/PJP	3709

7590

02/13/2003

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EXAMINER

SODERQUIST, ARLEN

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/691,776

Applicant(s)  
Mountford et al.

Examiner  
Arlen Soderquist

Art Unit  
1743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacKinnon (*Radiology*, 1997) in view of Somorjai (*Magnetic Resonance in Medicine*, 1995). In the paper MacKinnon discusses fine-needle biopsy specimens of benign breast lesions distinguished from invasive cancer ex vivo with proton MR spectroscopy. To determine whether invasive breast cancer can be distinguished from benign lesions with proton magnetic resonance (MR) spectroscopy ex vivo on the basis of altered cellular chemistry. Two hundred eighteen fine-needle biopsy specimens were obtained in 191 patients undergoing surgery and were analyzed with proton MR spectroscopy. MR spectroscopic and histopathologic findings were compared. Invasive carcinoma produced increased signal at 3.25 ppm, attributable to choline-containing metabolites. Discrimination between invasive carcinoma (n = 82), benign lesions (n = 106), or carcinoma in situ (n = 17) was based on the resonance intensity at 3.25 ppm standardized to the resonance at 3.05 ppm (P lt .001). The ratio of peak height intensities of resonances at 3.25 to those at 3.05 ppm was less than 1.7 in 102 of the 106 normal or benign lesions. All carcinoma in situ specimens with comedonecrosis or a microinvasive component (n = 6) were categorized at MR spectroscopy with invasive carcinoma, while others with in situ disease alone were categorized with benign lesions (n = 11). The sensitivity and specificity of MR spectroscopy in

fine-needle biopsy specimens in distinguishing benign lesions from invasive cancer were 95% and 96%, respectively. The paper concluded that proton MR spectroscopy of fine-needle biopsy specimens provides objective diagnostic information that complements findings of conventional preoperative investigations of breast lesions. relative to the instant claims is the paragraph bridging the columns 2-3 of page 664. The last sentence of the paragraph cites the Somorjai reference and teaches that the multivariate techniques of the reference are "likely to improve sensitivity and specificity" of the analysis.

In the paper Somorjai presents computerized consensus diagnosis as a classification strategy for the robust analysis of  $^1\text{H}$  MR spectra of thyroid neoplasms. They developed and applied a new classification strategy called computerized consensus diagnosis (CCD). Its purpose is to provide robust, reliable classification of biomedical data. The strategy involves the cross-validated training of several classifiers of diverse conceptual and methodological origin on the same data, and appropriately combining their outcomes. The strategy is tested on proton magnetic resonance spectra of human thyroid biopsies, which are successfully allocated to normal or carcinoma classes. They used Linear Discriminant Analysis, a Neural Net-based method, and Genetic Programming as independent classifiers on two spectral regions, and chose the median of the six classification outcomes as the consensus. This procedure yielded 100% specificity and 100% sensitivity on the training sets, and 100% specificity and 98% sensitivity on samples of known malignancy in the test sets. They discuss the necessary steps any classification approach must take to guarantee reliability, and stress the importance of fuzziness and undecidability in robust classification.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the multivariate analysis methodology of Somorjai into the MacKinnon analysis of breast tissues because of the statement by MacKinnon directing one to the Somorjai multivariate method as likely to provide improved results and the teaching of improved analysis results by Somorjai.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are related to the use of multivariate analysis techniques to

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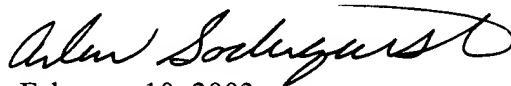
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the investigation of cancer tissues by magnetic resonance spectroscopy (MRS) and the use of MRS to identify cancerous tissues.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arlen Soderquist whose telephone number is (703) 308-3989. The examiner's schedule is variable between the hours of about 5:30 AM to about 5:00 PM on Monday through Thursday and alternate Fridays.

For communication by fax to the organization where this application or proceeding is assigned, (703) 305-7719 may be used for official, unofficial or draft papers. When using this number a call to alert the examiner would be appreciated. Numbers for faxing official papers are 703-872-9310 (before finals), 703-872-9311 (after-final), 703-305-7718, 703-305-5408 and 703-305-5433. The above fax numbers will generally allow the papers to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



February 10, 2003

ARLEN SODERQUIST  
PRIMARY EXAMINER